

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant:	Uwe Bacher	
Serial No.: 10/662,759	Conf. No.: 1909	Filing Date: Sept. 15, 2003
Title of Application:	Medical Instrument	
Group Art Unit: 3731	Examiner: Lang, Amy T.	

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Reply Brief Under 37 CFR §41.41**

Dear Sir:

Having received the Examiner's Answer, Appellant submits this Reply Brief for the above-captioned application pursuant to 37 C.F.R. §41.41 as follows.

## Reply to Examiner's Responses

Appellant has fully set forth its arguments for patentability in its previously filed Appeal Brief. Herein, Appellant briefly addresses the Examiner's Responses to Appellant's arguments, as set forth in the Examiner's Answer.

As noted in Appellant's Appeal Brief, all of the presently appealed claims are directed to a medical instrument that includes a tool mounted on the end of a shaft. The tool is detachably secured on an activation rod by means of a tool shaft. The tool shaft and the activation rod are brought into engagement with one another by means of a movement exclusively in one direction that is essentially perpendicular to the longitudinal axis of the activation rod, and the components coupled to one another are fixed relative to one another in all other directions.

The Examiner has maintained that Strait (U.S. Patent No. 2,334,449) discloses this unique coupling between the activation rod and the tool shaft, despite the fact that Strait clearly discloses that the male member 10 and the female member 11 are engageable using a movement in either of two directions. Because Strait does not disclose that the male member 10 and the female member 11 are engaged by a movement exclusively in one direction, the Examiner's suggested combination of Strait with LeMarie (U.S. Patent No. 5,366,477) would not result in the claimed invention.

Figures 4 and 5 of Strait show that male member 10 and female member 11 may be engaged by either a downward movement of the male member 10 toward the female member 11 or an upward movement of the male member 10 toward the female member 11. However, on page 5 of the Examiner's Answer, the Examiner argues that "a direction is the line or course on which something is moving (Merriam-Webster dictionary)." The Examiner goes on to argue that, based on this definition, member 10 of Strait moves exclusively in one direction even though it may be moved either downwardly or upwardly into engagement with female member 11. The Examiner further argues that even the activation rod and the tool shaft of the present application do not move in exclusively one direction, since the rod and shaft may be brought into

engagement using a downward movement of the rod or using an upward movement of the rod, depending on the orientation of the components.

Appellant respectfully submits that these arguments ignore what is implicitly recited in the claims and what a person of ordinary skill in the art would understand the claims to mean. The words in a claim are too be given “the broadest reasonable meaning...in their ordinary usage as they would be understood by one of ordinary skill in the art.” *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)(emphasis added). Further, “claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983)(citations omitted, emphasis in original).

In light of the specification and drawings of the present application, one of ordinary skill in the art would never interpret the phrase “movement exclusively in one direction” as recited in the claims to mean movement in one of two opposing directions. The specification and drawings clearly show that the activation rod and the tool shaft are designed so that the activation rod will engage the tool shaft when it approaches the tool shaft in a single direction when the components are in a specific orientation relative to one another. (See, *e.g.*, Figures 2a, 2b, 3, and 4 and the associated written description). The components of Strait, however, are engageable by movement in one of two permitted directions when the components are in a specific orientation relative to one another. One of ordinary skill in the art would easily understand the distinction between the claimed “movement exclusively in one direction” and the two directions of movement for engagement that are permitted by the design of the components of Strait. By arguing that Strait discloses only “one direction” of movement for engagement of the components and ignoring this important difference between the device of Strait and the device of the present claims, the Examiner is ignoring the most reasonable interpretation that one of ordinary skill in the art would ascribe to the claims.

Other aspects of the Strait device provide further evidence of the difference between that device and the claimed invention. Since the male member 10 can move relative to the female member 11 in two directions (upwardly or downwardly), a

threaded collar 20 is required to secure the members 10 and 11 to prevent them from disengaging. Such a collar is not required in the present invention because the components coupled to one another are fixed relative to one another in all directions except the direction of engagement.

Next, it is implicit in the claims when they are read in light of the specification and drawings that the "one direction" recited therein is relative to the components themselves and not relative to some external, objective reference frame. The Examiner argued that the activation rod and the tool shaft of the present claims can be engaged by movements in more than one direction because the components can be engaged while in a variety of orientations relative to an objective reference frame. The drawings and written description make clear how the actuation rod and the tool shaft are engaged. It is implicit in the claims and easily understood by those of ordinary skill in the art that the "one direction" is relative to the tool shaft and actuation rod, *i.e.*, the components themselves.

Appellant respectfully submits that reading the claims as the Examiner has done effectively removes the limitation of "movement exclusively in one direction" for engagement of the actuation rod with the tool shaft from the claims. Interpreting the phrase "movement in exclusively one direction" to include both the movement for engagement used in the present claims and the movements for engagement used in Strait renders the terms "exclusively in one direction" meaningless. This phrase cannot include both the movements permitted by Strait and the movement permitted by the present claims.

In short, Strait does not disclose a means of coupling an activation rod and a tool shaft using a movement exclusively in one direction. Thus, even if one were to combine the teachings of LeMarie with those of Strait as the Examiner has suggested, one would not arrive at the invention of the present claims.

For the foregoing reasons, as well as those set forth in Appellant's previously filed Appeal Brief, Appellant respectfully submits that the claimed invention embodied in

each of claims 1-12 is patentable over the cited prior art. As such, Appellant respectfully requests that the rejections of each of claims 1-12 be reversed.

Respectfully submitted,

/Wesley W. Whitmyer, Jr./

Wesley W. Whitmyer, Jr., Registration No. 33,558

Todd M. Oberdick, Registration No. 44,268

Attorneys for Applicant-Appellant

ST.ONGE STEWARD JOHNSTON & REENS LLC

986 Bedford Street

Stamford, CT 06905-5619

203 324-6155

Attorneys for Applicant-Appellant